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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,332	02/15/2002	Yuji Ishihara	2599 USOP	5909

7590 04/19/2004

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EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/030,332

Applicant(s)

ISHIHARA ET AL.

Examiner

Celia Chang

Art Unit

1625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


CEILACHANG
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Art Unit: 1625

--ATTACHMENT TO ADVISORY--


The amendment and arguments presented in paper no. 14, dated Feb. 20, 2004 will not be entered for the following reason:

Applicants amended the specification and claims and argued that "Should the examiner chose to continue to deny the benefit of priority she is kindly requested to specify which parts of the claims are not supported by the priority document"

To gain priority benefit under 35 USC 119, an application must be of the "same" invention as filed in a foreign priority filing (please consult 35 USC 119 statute). Please note that at least to the extent of the instant application wherein amendments were attempted on pages 9-10 of the specification as compared to the certified translation pages 12-13, none of the structural formula as disclosed on pages 9-10 (paragraph bridging) was found and neither were the substituents "include hydroxy group....." (see beginning of the same paragraph) were identical.

Please note that the above discrepancy is not an exhausted listing of the many non-supporting descriptions found between the instant specification and the foreign priority translation. The examiner pointed out the non-identical invention between the instant filing and its claimed priority documents, thus, benefit of priority claiming can not be granted. It is not the Examiner's job to identify every single discrepancy between the two documents. To gain priority benefit, the two inventions must be the "same" i.e. the specification must be identical other than some spelling/grammatical differences.

Not only such issue of identical invention was not resolved, the amendments did not obviate the rejections of record but further contain more new matter was the amendment be entered into the specification.


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